

**IN THE U.S. DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

APPLE INC.,

*Plaintiff,*

v.

MASIMO CORPORATION and  
SOUND UNITED, LLC,

*Defendants.*

MASIMO CORPORATION and  
CERCACOR LABORATORIES, INC.,

*Counter-Claimants,*

v.

APPLE INC.

*Counter-Defendant.*

C.A. No. 22-1378-MN-JLH

**JURY TRIAL DEMANDED**

**DECLARATION OF EDWARD M. CANNON IN SUPPORT OF  
DEFENDANTS MASIMO CORPORATION AND SOUND UNITED, LLC'S  
MOTION FOR STAY PENDING INTER PARTES REVIEW**

I, Edward M. Cannon, declare as follows:

1. I am a partner with the law firm of Knobbe, Martens, Olson & Bear, LLP, counsel of record for Defendants Masimo Corporation and Sound United, LLC in the above-captioned matter. I have personal knowledge of the matters set forth herein and if I am called upon to testify, I could and would testify competently thereto.

2. I submit this Declaration in support of Defendants' Motion for Stay pending IPR.

3. Masimo filed petitions for IPR challenging the patentability of each of Apple's asserted utility patents. I am counsel of record for Masimo in each of these petitions.

4. On February 27, 2023, Masimo filed petition IPR2023-00634 challenging all claims 1-20 of the '783 patent. On September 25, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 1** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00634.

5. On February 27, 2023, Masimo filed petition IPR2023-00635 challenging all claims 1-20 of the '054 patent. On September 18, 2023, the USPTO denied institution of IPR. Attached hereto as **Exhibit 2** is a true and correct copy of the USPTO's decision denying institution of IPR2023-00635. On October 18, 2023, Masimo filed a request for rehearing of the Board's decision denying institution.

6. On March 6, 2023, Masimo filed petition IPR2023-00664 challenging all claims 1-24 of the '352 patent. On September 20, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 3** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00664. On December 13, 2023, Apple moved to conditionally amend challenged claims 3-5, 7, 8, 11-13, 15, 16, 19-21, 23, and 24 of the '352 patent. Attached

hereto as **Exhibit 4** is a true and correct copy of Patent Owner's Contingent Motion to Amend in IPR2023-00664.

7. On March 20, 2023, Masimo filed petition IPR2023-00734 challenging all claims 1-19 of the '491 patent. On October 5, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 5** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00734.

8. On March 22, 2023, Masimo filed petition IPR2023-00745 challenging claims 1-4 and 8-22 of the '257 patent. On October 16, 2023, the USPTO instituted IPR on all grounds set forth in the petition. Attached hereto as **Exhibit 6** is a true and correct copy of the USPTO's decision granting institution of IPR2023-00745. Attached hereto as **Exhibit 7** is a true and correct copy of an email that Grace Kim, counsel of record for Apple in IPR2023-00745, sent to the trials@uspto.gov on December 14, 2023. As shown therein, Ms. Kim states: "Patent Owner, Apple Inc., intends to file a motion to amend in the IPR2023-00745 proceeding."

9. On April 4, 2023, Masimo filed petition IPR2023-00807 challenging all claims 1-20 of the '483 patent. On November 21, 2023, the USPTO denied institution of IPR. Attached hereto as **Exhibit 8** is a true and correct copy of the USPTO's decision denying institution of IPR2023-00807.

10. Attached hereto as **Exhibit 9** is a true and correct copy of Defendant Apple Inc.'s Memorandum of Points and Authorities in Support of Its Motion to Stay the Patent Infringement

Case Pending *Inter Partes* Review Proceedings in *Masimo Corp. et al. v. Apple Inc.*, Case No. 8:20-cv-00048-JVS-JDE (C.D. Cal.).

11. Attached hereto as **Exhibit 10** is a true and correct copy of the redacted Order Regarding Motion for Stay by Judge James V. Selna in *Masimo Corp. et al. v. Apple Inc.*, Case No. 8:20-cv-00048-JVS-JDE (C.D. Cal.).

12. Attached hereto as **Exhibit 11** is a true and correct copy of Apple's Opposition to AliveCor's Motion to Stay Pending *Inter Partes* Review in *Apple Inc. v. AliveCor, Inc.*, Case No. 4:22-cv-07608-HSG (N.D. Cal.).

13. Attached hereto as **Exhibit 12** is a true and correct copy of a printout of a December 19, 2023 Docket Navigator documents search using search parameters "Types of Document: Motion to Stay Pending Inter Partes Review" and "Defendants: Apple Inc.".

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on December 20, 2023, in Irvine, California.

/s/ Edward M. Cannon  
Edward M. Cannon

**CERTIFICATE OF SERVICE**

I hereby certify that on December 20, 2023, I electronically filed the foregoing with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

I further certify that I caused to be served copies of the foregoing document on December 20, 2023, upon the following in the manner indicated:

***VIA ELECTRONIC MAIL:***

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Dated: December 20, 2023

/s/ *Megan C. Haney*  
Megan C. Haney (#5016)